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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,666	04/27/2000	Dean J. Blackketter	MS1-413US	4370

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,666

Applicant(s)

BLACKKETTER ET AL.

Examiner

Hunter B. Lonsberry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 36, 38 and 40-46 is/are rejected.
- 7) ☒ Claim(s) 37, 39 and 47 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, and 36-47 are drawn to updating a channel status list to indicate that a program is being viewed in an interactive mode, classified in class 725, subclass 9.
 - II. Claims 15-19 and 48-50 are drawn to displaying a TV program on a first channel, changing to a second channel and displaying a program associated with the second channel, determining an interactive TV mode from the channel status list for the second channel, and opening an interactive window if the second channel is in interactive mode, classified in class 725, subclass 14.
 - III. Claims 20-25 are drawn to displaying an indicator if a TV program supports an interactive mode and a different indicator for an online mode, classified in class 725, subclass 61.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects (MPEP 806.04, MPEP 808.01). In the instant case, inventions I, II and III have different modes of operation.

These inventions are distinct for the reasons given above, and the search required for each group is different and not co-extensive for examination purposes. For

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example, the searches for the inventions would not be co-extensive because these groups would require different searches on the PTO's classification class and subclass as follows:

(a) the group I search (claims 1-14, and 36-47) would require the search of Class 725, subclass 9 (not required for invention II/III).

(b) the group II search (claims 15-19 and 48-50) would require the search of Class 725, subclass 14 (not required for invention I/III).

(c) the group III search (claims 20-25) would require the search of Class 725, subclass 61 (not required for invention I/II).

During a telephone conversation with Mr. Steven Sponseller on August 6, 2003, a provisional election was made with traverse to prosecute the invention of group I, claims 1-14, and 36-47. Affirmation of this election must be made by applicant in replying to this office action. Claims 15-25 and 48-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 36, 38, and 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,240,555 to Shoff in view of U.S. Patent 5,850,249 to Massetti.

Regarding claims 1-5, 8-12, 36, 45 and 46 Shoff discloses an interactive entertainment system in Figure 8a, in which a user may way a program, if interactive content is available, a video icon 204 appears, a user may then actuate the icon 204 and opens the supplemental content which may include web content stored on an outside ISP via a browser (column 5, line 6-column 6, line 67, column 7, lines 26-50, column 9, line 8-column 10, line 58). Shoff does not disclose updating a list to indicate that an interactive program is being viewed. Massetti discloses a viewer monitoring system which utilizes an identification code and time stamp to figure out what program a user is watching, additionally, it monitors to see if a user is utilizing a VCR or playing a video game, the monitoring results are stored locally and then transmitted from home computer 82 to a central office (column 6, lines 48-67, column 7, lines 22-67, column 9, lines 11-24, line 57-column 10, line 16, column 13, lines 25- column 14, line 12, line 37column 15, line 50, column 16, lines 8-67). Therefore it would have been obvious to one skilled in the art at the time of invention to modify Shoff to include the monitoring

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features of Massetti, including connecting to an external device and at what time, in order to figure out what programs users are watching for advertising purposes.

Regarding claims 6 and 13, Shoff discloses an interactive entertainment system in Figure 8a, in which a user may way a program, if interactive content is available, a video icon 204 appears, a user may then actuate the icon 204 and opens the supplemental content which may include web content stored on an outside ISP via a browser, after a set time the icon fades away (column 9, line 8-column 10, line 58).

Regarding claims 7 and 14, Shoff discloses in figure 5, viewer computing unit 90 which contains memory 92 and 96 and processor 94, OD 101 is run on the computer unit 90 (column 8, lines 4-51). Massetti discloses that the monitoring results are stored/updated on a home computer 82 (column 6, lines 48-67, column 7, lines 22-67, column 9, lines 11-24, line 57-column 10, line 16, column 13, lines 25- column 14, line 12, line 37column 15, line 50, column 16, lines 8-67).

Regarding claim 38, Shoff discloses the use of a program tuner 98 and modem/tuner 100 for supplemental content (Figure 5, column 8, lines 35-51).

Regarding claims 40-44, Shoff discloses an interactive entertainment system in Figure 8a, in which a user may way a program, if interactive content is available, a video icon 204 appears, a user may then actuate the icon 204 and opens the supplemental content which may include web content stored on an outside ISP via a browser (column 5, line 6-column 6, line 67, column 7, lines 26-50, column 9, line 8-column 10, line 58). Shoff's storage device inherently receives updates from the processor to add and delete television channels from the interactive mode, as the processor must inform the storage

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device that the interactive mode has been entered or exited, thus beginning or ending display of data which is stored in the storage device's buffer and received from modem/tuner 100. Shoff does not disclose updating a list to indicate that an interactive program is being viewed. Massetti discloses a viewer monitoring system which utilizes an identification code and time stamp to figure out what program a user is watching, additionally it monitors to see if a user is utilizing a VCR or playing a video game, the monitoring results are stored locally and then transmitted from home computer 82 to a central office (column 6, lines 48-67, column 7, lines 22-67, column 9, lines 11-24, line 57-column 10, line 16, column 13, lines 25- column 14, line 12, line 37column 15, line 50, column 16, lines 8-67). Therefore it would have been obvious to one skilled in the art at the time of invention to modify Shoff to include the monitoring features of Massetti, including connecting to an external device and at what time, in order to figure out what programs users are watching for advertising purposes.

Allowable Subject Matter

Claims 37, 39 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday during normal business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5359 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

HBL
August 7, 2003


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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